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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/776,452	02/02/2001	David J. Boothby	05110-016002	9348

26161 7590 03/19/2003

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225 FRANKLIN ST
BOSTON, MA 02110

EXAMINER

COBY, FRANTZ

ART UNIT	PAPER NUMBER
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2171

DATE MAILED: 03/19/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/776,452

Applicant(s)
Boothby et al.

Examiner
Frantz Coby

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2171



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Feb 2, 2001
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 53-90 is/are pending in the application.
- 4a) Of the above, claim(s) NONE is/are withdrawn from consideration.
- 5) ☒ Claim(s) NONE is/are allowed.
- 6) ☒ Claim(s) 53-90 is/are rejected.
- 7) ☒ Claim(s) NONE is/are objected to.
- 8) ☒ Claims NONE are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 3, 5 6) ☐ Other:

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This is in response to application filed on February 02, 2001 and Preliminary amendments filed on February 02, 2001 and April 05, 2001 in which claims 53-90 are presented for examination.

Claims Status

Claims 53-90 are pending.

Information Disclosure Statement

1. The information disclosure statement filed May 01, 2001 and October 17, 2002 are in compliance with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609. They have been placed in the application file, and the information referred to therein has been considered as to the merits.

Claim Objections

2. Claims 53-90 are objected to because of the following informalities: Claims 53-54 and 66-67 recite "the records" in line 2. However, there was no recitation in the claims, or whether, the first and second database store a plurality of records.

Appropriate correction is required.

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or

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improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 53-90 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-52 of U.S. Patent No. 6,212,529 and over claims 1-80 of U.S. Patent no. 6,141,664. Although the conflicting claims are not identical, they are not patentably distinct from each other because the independent claims of the present application, namely claims 53-54 and 66-67, recite synchronizing a first and second database that include "fields" previously presented in the U.S. patent 6,212,529 as "text field". Also, U.S. Patent no. 6,141,664 recites synchronizing a first and a second database that include "records". The omission of the word "text" in the presented claims does not prevent occurrence of

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synchronizing a first and second database to be achieved. Therefore, one of ordinary skill in the art at the time of the invention would have found it obvious to have substitutes the text field of the U.S. Patent 6,212,529 with a field because it is essential for database record to be stored or structured as a collection of fields especially in a relational database. Further, one of ordinary skill in the art at the time of the invention would have recognized that the records of U.S. Patent 6,141,664 is simply a data structure that is a collection of field. Therefore, one of ordinary skill in the art at the time of the invention would have realized that synchronizing two databases that include fields is primarily incorporated in a system that is synchronizing two databases that include records. The Applicant is reminded that Omission of element and its function in combination is obvious expedient if remaining elements perform same function as before. In re KARLSON, 136 USPQ 184 (CCPA 1963). In this case, the same function of synchronizing a first database and a second database is achieved in all three the U.S. Patent 6,212,529, U.S. Patent 6,141,664 and the present application.

Conclusion

Any response to this action should be mailed to:

Commissioner of Patents and trademarks

Washington, D.C. 20231

or faxed to:

(703) 305-9051, (for formal communications)

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intended for entry)

Or:

(703) 308-5357 (for informal of draft

communications, please label "PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2021 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frantz Coby whose telephone number is (703) 305-4006. The examiner can normally be reached Monday through Friday from 9:30 A.M. to 5:00 P.M.

6. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic, can be reached on (703) 308-14367. The Fax phone number for this Group is (703) 746-7238; (703) 746-7239; (703) 746-7240.


FRANTZ COBY
PRIMARY EXAMINER

Technology Center 2171

March 17, 2003